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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,458	02/27/2002	Lawrence G. Shubert	021532-000100US	6663
34755	7590	03/17/2006	EXAMINER	
ADAM K. SACHAROFF MUCH SHELST FREED DENENBERG AMENT&RUBENSTEIN,PC 191 N. WACKER DRIVE SUITE 1800 CHICAGO, IL 60606-1615			MANAHAN, TODD E	
		ART UNIT		PAPER NUMBER
		3732		
DATE MAILED: 03/17/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/087,458	SHUBERT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Todd E. Manahan	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 27 December 2005.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4)  Claim(s) 27,28,30,34-40,42-44,46,47 and 49-54 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 27,28,30,34-40,42-44,46,47 and 49-54 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 27 December 2005 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date . . . .  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: . . . .

***Drawings***

The drawings are objected to because the lines, numbers, and letters are clean and uniformly thick and well-defined (see 37 CFR 1.84(l)). **Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.** Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. **The objection to the drawings will not be held in abeyance.**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 34, 50 and 53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 34, 50, and 53 recite the transfer member moving the head in two motion including “oscillation and another selected from rotational, lateral, and orbital motion”, however the application as originally filed does not provide adequate support for such a transfer member that cause both motions. The application as originally filed, though stating multiple motions are possible, does not describe how the transfer member accomplishes such task. One skilled in the art, based upon applicant’s disclosure, would be enabled to make a transfer member producing only a single type of motion, but would be unable to ascertain how to make a transfer member that produces oscillation through a fixed arc AND either rotational, lateral, or orbital motion. As such one skilled in the art would be unable to make and/or use the invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 37, 39, and 51 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Grahame (United States Patent No. 4,643,207).

Grahame discloses an apparatus comprising an elongated mobile housing member 12 having a shape and size suitable for being held in a single hand of a user; an electric drive 14

within and coupled to the housing and including a transfer member 48; a power supply 20 contained within the housing to supply power to the electric drive when activated; a movable head 46 positioned on the housing and coupled to the transfer member, the head being adapted to oscillate through a fixed arc; and an abrasive surface coupled to the movable head and having a grit.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27, 28, 30, 35, 38, 42, 43, 44, 46, 47, 49 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grahame in view of Ouchi et al. (Japanese Patent No. 2001037536A).

Grahame discloses the invention essentially as claimed except for the shock absorbing member coupled between the head and the abrasive surface. Ouchi et al. disclose a nail file having a shock absorbing member, in the form of a pair of springs (see figure 4) to create a resilient filing surface. It would have been obvious to one skilled in the art to provide the device of Grahame with a shock absorbing member coupled between the head and the abrasive surface in view of Ouchi et al. in order to create a resilient filing surface. Regarding claims 30 and 46, to adapt the head for oscillation of between 5 and 180 degrees would have been obvious to one having ordinary skill in the art at the time the invention was made, since it has been held that

where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grahame in view of Ouchi et al. as applied to claim 27 above, and further in view of Daley (United States Patent No. 6,145,512).

Daley discloses it is known in the art to provide nail files with a graphic design. It would have been obvious to one skilled in the art to provide the device of Grahame as modified by Ouchi et al. with a graphic design on the abrasive surface in view of Daley in order to make the device more aesthetically pleasing.

Claims 40, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grahame.

To adapt the head for oscillation of between 5 and 180 degrees would have been obvious to one having ordinary skill in the art at the time the invention was made, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

#### *Response to Arguments*

Applicant's arguments with respect to claims 27, 28, 34-40, 42-44, 46-47, 49-54 have been considered but are moot in view of the new ground(s) of rejection.

#### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Decker (United States Patent No. 2,350,098) discloses a sander having a moveable

head which oscillates. Wurst (United States Patent No. 6,099,397) discloses a sander having a moveable head which oscillates.

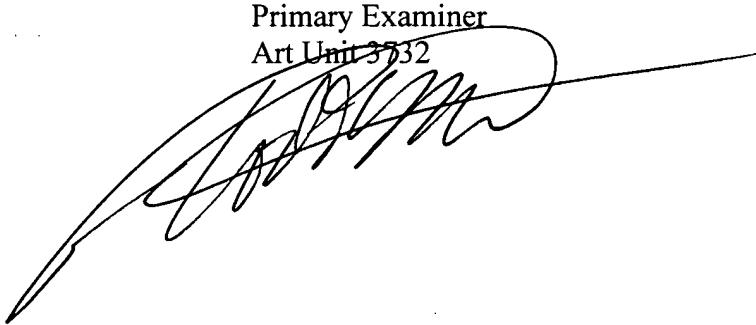
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd E. Manahan whose telephone number is 571 272- 4713. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571 273-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Todd E. Manahan  
Primary Examiner  
Art Unit 3732

T.E. Manahan  
14 March 2006

A handwritten signature in black ink, appearing to read "Todd E. Manahan", is written over a stylized, swooping line that extends from the bottom left towards the top right of the page. The signature is written in a cursive, fluid style.